

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

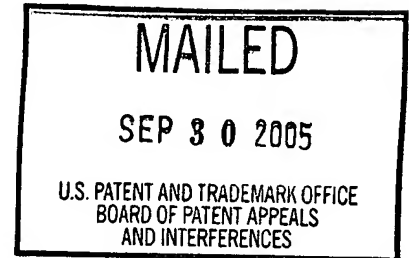
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte BOUDIAF BOUSSOUIRA and CHRISTIAN COLIN

Appeal No. 2005-1846
Application No. 09/083,150

ON BRIEF¹



Before SCHEINER, ADAMS and MILLS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

ON REMAND TO THE EXAMINER

Claims 1-44 are pending. Claims 1-28, 33-35, and 37 stand rejected. Claims 29-32, 36 and 38-44 were withdrawn from consideration as drawn to nonelected subject matter. On consideration of the record we find this case is not in condition for a decision on appeal. For the reasons that follow, we vacate² the pending rejection under 35 U.S.C. § 103 and remand the application to the examiner to consider the following issues and to take appropriate action.

¹ In accordance with 37 CFR § 41.73(f), the Board decided that the oral hearing scheduled for October 18, 2005 is not necessary in this appeal.

² Lest there be any misunderstanding, the term "vacate" in this context means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists.

Claims 1, 24 and 37 are illustrative of the subject matter on appeal and are reproduced below:

1. A cosmetic and/or dermatological composition comprising, in a cosmetically and/or dermatologically acceptable support:
 - at least one nanopigment in said composition,
 - at least one polyamino polymer in said composition selected from:
 - (A) polyalkylenepolyamine polymers selected from:
 - (i) polyalkylenepolyamines;
 - (ii) alkyl derivatives of polyalkylenepolyamines;
 - (iii) addition products of alkylcarboxylic acids with polyalkylenepolyamines;
 - (iv) addition products of ketones and aldehydes with polyalkylenepolyamines;
 - (v) addition products of isocyanates and isothiocyanates with polyalkylenepolyamines;
 - (vi) addition products of alkylene oxide and polyalkylene oxide block polymers with polyalkylenepolyamines;
 - (vii) quaternized derivatives of polyalkylenepolyamines;
 - (viii) addition products of a silicone with polyalkylenepolyamines; and
 - (ix) copolymers of dicarboxylic acid and of polyalkylenepolyamines.
24. A cosmetic and/or dermatological composition according to claim 1, wherein said composition further comprises at least one metal-complexing agent.
37. An antioxidant composition comprising at least one polyamino polymer in said composition selected from:
 - (A) polyalkylenepolyamine polymers selected from:
 - (i) polyalkylenepolyamines;
 - (ii) alkyl derivatives of polyalkylenepolyamines;
 - (iii) addition products of alkylcarboxylic acids with polyalkylenepolyamines;
 - (iv) addition products of ketones and aldehydes with polyalkylenepolyamines;
 - (v) addition products of isocyanates and isothiocyanates with polyalkylenepolyamines;
 - (vi) addition products of alkylene oxide and polyalkylene oxide block polymers with polyalkylenepolyamines;
 - (vii) quaternized derivatives of polyalkylenepolyamines;
 - (viii) addition products of a silicone with polyalkylenepolyamines; and
 - (ix) copolymers of dicarboxylic acid and polyalkylenepolyamines;

wherein said polyamino polymer is present in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids.

The references relied upon by the examiner are:

Wolf et al. (Wolf)	5,449,519	Sep. 12, 1995
Garrison et al. (Garrison)	5,569,651	Oct. 29, 1996
Fanchon et al. (Fanchon)	5,679,374	Oct. 21, 1997

GROUND OF REJECTION

Claims 1-23, 27, 28, 33-35 and 37 stand rejected under 35 U.S.C. § 103, as being unpatentable over the combination of Wolf and Fanchon.

Claims 24-26 stand rejected under 35 U.S.C. § 103, as being unpatentable over the combination of Wolf, Fanchon and Garrison.

We vacate the pending rejections and remand the application to the examiner.

DISCUSSION

The combination of Wolf and Fanchon:

Claims 1-23, 27, 28, 33-35 and 37 stand rejected under 35 U.S.C. § 103, as being unpatentable over the combination of Wolf and Fanchon.

Appellants present a number of arguments in response to the rejection of claims 1-23, 27, 28, 33-35 and 37 under 35 U.S.C. § 103, as being unpatentable over the combination of Wolf and Fanchon. For clarity, we outline the arguments below:

- I. “[T]he [e]xaminer failed to establish that either Wolf or Fanchon teaches or suggests the at least one polyamino polymer chosen from polyalkylenepolyamine polymers (i) – (ix), as claimed in, for example, claim 1 of the present invention.” Brief, page 6, emphasis removed.
- II. “The [e]xaminer failed to provide any evidence of suggestion or motivation to choose nanopigments from various active ingredients disclosed in Fanchon.” Brief, page 10, emphasis removed.
- III. “It may have been, at best, obvious to try each synthetic polymer disclosed in Wolf to form a complex, and each active agent, such as antioxidants and nanopigments, disclosed in Fanchon and combine them in an attempt to arrive at the claimed invention.” Brief, page 12, emphasis removed.

Appellants group claim 37 separately from claims 1-23, 27, 28, and 33-35 (see Brief, page 3), and provide the following separate argument with regard to claim 37.

- IV. “[N]either Wolf nor Fanchon teaches or suggests that the ‘polyamino polymer is present in an amount effective to inhibit light-induced peroxidation of proteins, protein derivatives, and lipids’ as recited in claim 37 of the present invention.” Brief, page 13, emphasis removed.

Against this backdrop of what appellants perceive to be the deficiencies in the examiner’s prima facie case of obviousness, we turn to the examiner’s statement of the rejection. Given its brevity, we reproduce the examiner’s statement of the rejection as it appears on page 2 of the Paper mailed August 29, 2003:

Wolf et al. teach an anti-acne composition comprising 0.01-25% of a carrier complexed to active (abstract). 40%-50% carrier is specified (column 4[,] lines 11-13). Dendritic polymers are specified (column 3[,] lines 42-44). Titanium oxide is specified (column 6[,] line 34). Stearic acid and jojoba oil are disclosed (column 5[,] line 53 and column 6[,] line 50). Sunscreens are specified (column 4[,] lines 31-32). Emulsions are disclosed (column 4[,] lines 43-44).

Fanchon et al. teach anti-acne compositions containing antioxidants and nanopigments as active agents (title, Abstract, column 7[,] lines 7-9, 11, 13, 29-30).

It would have been obvious to one of ordinary skill to add an antioxidant and nanopigments to the composition of Wolf et al. [t]o achieve the beneficial effect of additional anti-acne active in view of Fanchon et al.

In our opinion, this statement of the rejection is not susceptible to a meaningful review. As a starting point, we agree with appellants' assertion (Brief, page 6) that the examiner failed to state on this record whether Wolf, Fanchon, both or neither, teach or suggest a "polyamino polymer chosen from polyalkylenepolyamine polymers (i) – (ix)" as set forth, for example, in appellants' claim 1. It can only be assumed from the examiner's statement of the rejection that the examiner may be of the opinion that "[d]endritic polymers" relate in some way to polyalkylenepolyamines polymers.

The relevance of the examiner's reference to titanium oxide, stearic acid, jojoba oil, sunscreens and emulsions is unclear from the examiner's statement of the rejection. While these agents appear in some of appellants' rejected claims, the examiner provides no context for this listing, or explanation as to why any item is included in this listing. The examiner makes no attempt to explain how any part of the Wolf disclosure would apply to any claim under rejection, or in what manner the examiner believes Wolf differs from the claimed invention.

Further, the examiner's response to appellants' arguments is less than clear. Given its brevity, we reproduce the examiner's entire response to appellants' arguments (Answer, page 4),

[A]pplicants ignore the first sentence of the paragraph (column 3[,], lines 10-12) which states that "Salicyclic acid and Resorcinol have free acid groups which will ionically bond to the free amino groups of proteins and polymers." The examiner opines that in such ionic bonding the chemical structure of the polymer remains unchanged. Applicants, contrary to their intent, support the examiner's position by citing to column 2[,], lines 7-11 which discloses the dissociation of the Keratolytic compound from the carrier molecule. That is, the Keratolytic compound can dissociate because the binding applicants argue is ionic rather [than] covalent binding.

For the above reasons, it is believed that the rejections should be sustained.

Conspicuous by its absence, is any response to appellants' arguments outlined above. Further, while the examiner recognizes (e.g., Answer, page 3) appellants separate grouping of claim 37, the examiner fails to address appellants' separate argument regarding this claim.

For the foregoing reasons, we find that the examiner failed to adequately support the combination of the Wolf and Fanchone references in a manner that would render obvious appellants' claimed invention. At best the examiner selected and listed a series of words from each of the Wolf and Fanchone references. From this listing the examiner concluded that a person of ordinary skill in the art would have been motivated to combine the references, and therefore appellants' claimed invention was obvious. As set forth in Ecolochem Inc. v. Southern California Edison, 227, F.3d 1361, 1375, 56 USPQ2d 1065, 1075 (CAFC 2000) the:

"suggestion to combine may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." ... However, there still must be evidence that "a skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would

select the elements from the cited prior art references for combination in the manner claimed.” ... “[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”.... [Citations omitted].

On this record, we find it difficult to understand the examiner’s reasoning and whether the evidence upon which he relies supports the underlying fact findings for the rejections under 35 U.S.C. § 103. Accordingly, we vacate the rejection of claims 1-23, 27, 28, 33-35 and 37 under 35 U.S.C. § 103, as being unpatentable over the combination of Wolf and Fanchon, and remand the application to the examiner for further consideration.

Upon receipt of the application, we encourage the examiner to take a step back and reconsider the administrative file together with the available prior art. If after the review, the examiner is of the opinion that a rejection should be made under 35 U.S.C. § 103, we suggest the examiner review the Manual of Patent Examining Procedure (MPEP) § 706.02(j) for a model of how to explain a rejection under this section of the statute. Adherence to this model will of necessity require that the examiner consider the patentability of the claims in an individual manner and set forth the facts and reasons in support of why individual claims are unpatentable.

The combination of Wolf, Fanchon and Garrison:

Given its brevity, we reproduce the examiner’s statement of the rejection as it appears on pages 2-3 of the Paper mailed August 29, 2003, “Garrison et al[.] teach the chelator EDTA in anti-acne compositions to sequester

discoloration-causing metal ions. (Column 4[,] lines 3-4). It would have been obvious to one of ordinary skill to add a EDTA to the compositions of preventing discoloration in view of Garrison et al.” It is completely unclear from the examiner’s statement of the rejection how Wolf and Fanchon relate to “compositions of preventing discoloration,” to which the examiner believes a person of ordinary skill in the art would obviously add EDTA.

Accordingly, for this reason, as well as the reasons set forth above, we vacate the rejection of claims 24-26 under 35 U.S.C. § 103, as being unpatentable over the combination of Wolf, Fanchon and Garrison, and remand the application to the examiner for further consideration as set forth above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is not made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) does not apply.

VACATED and REMANDED

Toni R. Scheiner
Toni R. Scheiner

Toni R. Scheiner
Administrative Patent Judge

Donald E. Adams

Donald E. Adams
Administrative Patent Judge

Dentra J. Mills

Demetra J. Mills
Administrative Patent Judge

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